

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-6 were the subject of an appeal before the Board of Appeals and Interferences. The examiner has since withdrawn the final rejection and reopened prosecution. At present, Claims 1-6 stand rejected.

The specification and figures were objected to, respectively, for not showing what was described at page 6, lines 4-6 and page 7, lines 4-6. The figures have been separately amended to overcome this objection.

Claim 1 was objected to for claiming "heating elements" when only a single heating element was disclosed. Claim 1 has been amended to reflect this element, thereby overcoming the examiner's objection.

The examiner respectfully rejected Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Vanselow.

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The examiner respectfully rejected Claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Vanselow in view of Dam.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

In regard to Claims 1-4, 6 and 8, and as best understood by the limited translation provided, the examiner cited L'Oreal as disclosing a reservoir, a neck, liquid filling the reservoir, and a roller ball housed within a cylindrical sleeve. However, L'Oreal fails to disclose a *bulb* having a neck, and the arrangement of the second end of the sleeve in relation to the neck so that heat transfer can occur between the roller ball and the liquid in the reservoir. L'Oreal also fails to disclose a reservoir for holding liquid. As such, L'Oreal fails to disclose, teach or suggest every element of Claim 1 as required, therefore the examiner's rejection of Claim 1 is inappropriate and Claim 1 is considered allowable. Furthermore, Claims 2-4, 6, 8 and 10 depend from Claim 1, therefore Claims 2-4, 6, 8 and 10 are also considered allowable.

By way of further argument, in regard to Claim 6, the examiner cited figure 6 from L'Oreal as disclosing a barrier between the reservoir and sleeve. However, figure 6 does not

disclose a barrier. And, as is best understood, the specification does not disclose, teach or suggest a barrier between the reservoir and sleeve. Furthermore, the obviousness of providing the alleged barrier of figure 6 to the embodiment of figure 4 is not reasonable, otherwise, figure 4 would have included such a barrier and/or disclosed a barrier for figure 4 within the specification. As such, L'Oreal fails to disclose, teach or suggest every element of Claim 6, as required, therefore Claim 6 is considered allowable.

In regard to Claim 8, there is no recitation of L'Oreal disclosing a valve that renders Claim 8 unpatentable. Therefore, the rejection of Claim 8 is inappropriate, thus Claim 8 is considered allowable.

In regard to Claim 10, L'Oreal fails to disclose at least one arm projecting from a reservoir. Therefore, the rejection of Claim 10 is inappropriate, thus Claim 10 is considered allowable. Claims 11, 14 and 16 depend from Claim 10, directly or indirectly, therefore Claims 11, 14 and 16 are also considered allowable. Furthermore, in regard to Claim 14, L'Oreal fails to disclose a sleeve with a barrier to prevent liquid from flowing out of the reservoir, also rendering Claim 14 allowable.

For all the reasons and arguments cited above, the rejection of Claims 1-4, 6, 8, 10, 11, 14 and 16 is inappropriate, and Claims 1-4, 6, 8, 10, 11, 14 and 16 are considered allowable.

The examiner respectfully rejected Claims 5, 7, 12 and 15 under 35 U.S.C. § 103(a) as being unpatentable over L'Oreal in view of Glennan. Claim 7 has been canceled.

Claims 5, 12 and 15 depend from claims presently considered allowable, therefore Claims 5, 12 and 15 are also considered allowable.

The examiner respectfully rejected Claims 9 and 13 under 35 U.S.C. § 103(a) as being unpatentable over L'Oreal in view of Moriyama et al. Claims 9 and 13 have the same language.

Neither L'Oreal nor Moriyama disclose, teach or suggest the magnetization of the roller ball. Moriyama only discloses magnets (14 - Col. 2, Line 30), (59 - Col. 3, Lines 13-14), wherein the magnets are used for sealing and fastening. The magnets are simple magnets that would not generate the magnetized charges necessary to encourage and promote healing as disclosed by the present application. As such, L'Oreal nor Moriyama disclose, teach or suggest every element of Claims 9 and 13 as required, thus the rejection of Claims 9 and 13, respectfully, is inappropriate, therefore Claims 9 and 13 are presently considered allowable.

The examiner respectfully rejected Claims 17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over L'Oreal in view of York. Claims 17 and 19 have the same language.

Neither L'Oreal nor York disclose, teach or suggest a U-shaped reservoir, and the examination provides no recitation to such a disclosure. Specifically, York does not disclose a *reservoir* for holding liquid, but instead discloses a solid housing. There is no indication that the housing is for holding liquid, therefore, the motivation and/or suggestion to combine with the teachings of L'Oreal is lacking, thus the combination does not render Claims 17 and 19 unpatentable. Because L'Oreal and York fail to disclose, teach or suggest every element of Claims 17 and 19, as required, the rejection of Claims 17 and 19 is inappropriate, therefore Claims 17 and 19 are presently considered allowable.

The examiner respectfully rejected Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Pelton et al. in view of Moriyama et al. Claim 20 is canceled without

prejudice.

Therefore, in light of the numerous difference outlined above, the examiner's rejection of Claims 5, 9, 12, 13, 15, 17, 19 and 20 are inappropriate, and Claims 5, 9, 12, 13, 15, 17, 19 and 20 are presently considered allowable.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective

combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a message device with a reservoir having a bulb and neck, a liquid filling the reservoir, and a roller ball housed within a sleeve for rotatable movement, wherein the sleeve and neck portions permit transfer of heat between the roller ball and liquid. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

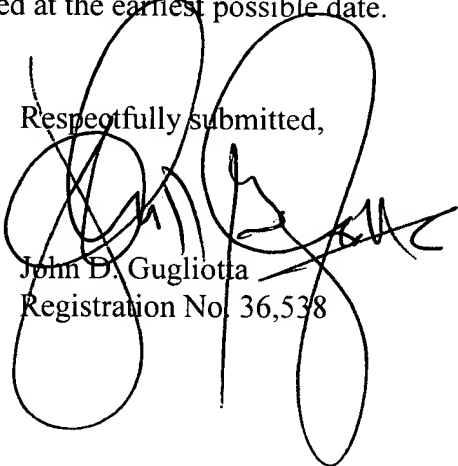
To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a

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formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,


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